

Appl. No. : 10/665,975  
Filed : September 18, 2003

### REMARKS

The Title of the Specification has been amended to be indicative of the invention of the examined claims. Claims 9 and 10 have been amended. Support for the amendments can be found in the Specification as filed, for example: [0021], and [0025]. Therefore, no new matter has been introduced by these amendments. The following addresses the substance of the Office Action.

#### Title

The Examiner has requested to amend the Title of the Invention to correspond to the elected claims. Applicant has amended the Title accordingly.

#### Compliance with 35 USC 101

The Examiner has rejected Claim 9 under 35 USC 101 as directed to non-statutory subject matter because it reads onto unpurified anti-Survivin antibody, i.e. product of nature. Claim 9 has been amended to recite “an isolated compound” and to exclude antibodies, therefore this rejection is now moot.

#### Compliance with 35 USC 112

The Examiner has rejected Claims 9 and 10 under 35 USC 112, second paragraph, as being indefinite for reciting “in the presence of HBXIP”. Claims 9 and 10 has now been amended to clarify that survivin interacts with HBXIP. Therefore, Claims 9 and 10 are now definite.

The Examiner has rejected Claims 9 and 10 under 35 USC 112, first paragraph as being allegedly non-enabled. Specifically, the Examiner has indicated, that while the specification enables anti-sense Survivin oligonucleotides and anti-Survivin antibodies as compounds that inhibit Survivin in the presence of HBXIP, undue experimentation would be required to make and use other compounds which are embraced by the claims. The applicant respectfully disagrees that undue experimentation is required to find other compounds that inhibit the interaction between Survivin and HBXIP. The Specification describes in detail the methods of making small molecules and then screening them for ability to inhibit the interaction of Survivin with HBXIP. However, to expedite the allowance of this application, claims 9 and 10 have now been amended to recite anti-sense Survivin oligonucleotides. Therefore, currently amended

Appl. No. : 10/665,975  
Filed : September 18, 2003

Claims 9 and 10 are now fully enabled. Applicant reserves the right to pursue the subject matter related to other types of inhibitors of survivin/HBXIP interaction in a related application.

The Examiner has rejected Claims 9 and 10 under 35 USC 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner indicated that while the Specification does disclose antisense oligonucleotides and anti-Survivin antibodies as compounds that possess the claimed inhibitory activity, it does not describe small molecules and peptide Survivin inhibitors. Claims 9 and 10 have been amended to recite anti-sense Survivin oligonucleotides. Therefore, currently amended Claims 9 and 10 are now fully supported by the Specification as filed, and their rejection under 35 USC 112, first paragraph should be withdrawn.

#### **Novelty**

The Examiner has rejected Claim 9 and 10 under 35 USC 102(b) as being allegedly anticipated by Banks et al. (*Blood* 2000 **96**:4002-4003). Specifically, Banks et al. disclose anti-Survivin antibody. Claim 9 has been amended to recite that the compound is selected from antisense nucleic acids. Therefore, currently amended Claim 9 is not anticipated by Banks et al., and the rejection of Claim 9 and 10 under 35 USC §102(b) should be withdrawn.

The Examiner has rejected Claim 9 and 10 under 35 USC 102(b) as being allegedly anticipated by Yagihashi et al. (*Clin. Chem.* 2001 **47**:1729-1731). Specifically, Yagihashi et al. disclose human sera comprising anti-Survivin antibody. Claim 9 has been amended to recite that the compound is selected from antisense nucleic acids. Therefore, currently amended Claim 9 is not anticipated by Yagihashi et al., and the rejection of Claim 9 and 10 under 35 USC §102(b) should be withdrawn.

Appl. No. : 10/665,975  
Filed : September 18, 2003

### CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 10, 2006

By: 

Marina L. Gordey  
Registration No. 52,950  
Agent of Record  
Customer No. 20,995  
(805) 547-5580

2520283  
041206